



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/546,932	04/11/2000	David Wilkins	DIGIP008	4441

22434 7590 11/03/2003

BEYER WEAVER & THOMAS LLP  
P.O. BOX 778  
BERKELEY, CA 94704-0778

EXAMINER
----------

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 11/03/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/546,932

**Applicant(s)**

WILKINS ET AL.

**Examiner**

Joseph R. Pokrzywa

**Art Unit**

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4-6</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for domestic priority under 35 U.S.C. 119(e) (to provisional applications).

### ***Information Disclosure Statement***

2. The references listed in the Information Disclosure Statements submitted on 8/18/00, 5/29/01, and 5/9/03 have been considered by the examiner (see attached PTO-1449's).

### ***Drawings***

3. The drawings received on 4/11/00 are acceptable.

### ***Specification***

4. The disclosure is objected to because of the following informalities:  
On page 1, line 18, "Application No. \_\_\_\_\_" should read "Application No. 09/547,185"; and  
on page 10, line 6, "requires" should read "require".

Appropriate correction is required.

***Claim Objections***

5. **Claims 20 and 28** are objected to because of the following informalities:

In **claim 20**, line 9, “digital image modification instruction” should read “digital image processing instruction”; and

in **claim 28**, line 1, “claim 29” should read “claim 27”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-4, 6-13, and 19** are rejected under 35 U.S.C. 102(e) as being anticipated by Barton (U.S. Patent Number 5,912,972).

Regarding **claim 1**, Barton discloses a method of modifying a first multimedia asset (column 5, line 64 through column 6, line 12, being a block of digital data) to form a second multimedia asset (being an authenticated digital block) comprising applying a multimedia asset processing command (information in the meta-data) to the first multimedia asset to form the second multimedia asset (column 6, lines 1 through 12), and uniquely linking the first multimedia asset to the second multimedia asset to the second multimedia asset using the

Art Unit: 2622

multimedia asset processing command such that the first multimedia asset is derivable solely from the second multimedia asset (column 6, lines 1 through 31).

Regarding **claim 2**, Barton discloses the method discussed above in claim 1, and further teaches that the applying comprises determining if the first multimedia asset (block of digital data) is associated with an edit list (being the meta-data) that includes the multimedia asset processing command (column 30 through 37), retrieving the edit list (column 6, line 55 through column 7, line 3), processing the first multimedia asset using the multimedia asset processing command included in the edit list (column 6, lines 1 through 20, and column 7, lines 4 through 15), and outputting the processed first multimedia asset in the form of the second multimedia asset (column 7, lines 16 through 53).

Regarding **claim 3**, Barton discloses the method discussed above in claim 2, and further teaches that the linking comprises associating an edit list pointer (being the meta-data bit string) with the second multimedia asset that points back to the edit list (column 6, line 55 through column 7, line 26, and column 7, lines 55 through 64).

Regarding **claim 4**, Barton discloses the method discussed above in claim 2, and further teaches that the linking comprises embedding the edit list in the second multimedia asset (column 6, lines 1 through 12, and column 6, line 55 through column 7, line 15).

Regarding **claim 6**, Barton discloses the method discussed above in claim 2, and further teaches that the applying is performed by a processor arranged to perform executable instructions (column 9, lines 41 through 55).

Regarding **claim 7**, Barton discloses the method discussed above in claim 6, and further teaches that the first multimedia asset and the second multimedia asset is a first digital image and a second digital image, respectively (column 5, line 64 through column 6, line 12).

Regarding **claim 8**, Barton discloses the method discussed above in claim 7, and further teaches that the multimedia processing command provides the processor with appropriate digital image processing instructions (column 6, line 55 through column 7, line 15, and column 8, lines 51 through 65).

Regarding **claim 9**, Barton discloses the method discussed above in claim 8, and further teaches that the processor is included in a host computer coupled to a distributed network of computers (column 1, lines 14 through 51, and column 5, line 64 through column 6, line 20).

Regarding **claim 10**, Barton discloses the method discussed above in claim 9, and further teaches that the second multimedia asset includes a watermark that includes the edit list (column 5, lines 32 through column 6, line 12, and column 6, line 66 through column 7, line 8).

Regarding **claim 11**, Barton discloses the method discussed above in claim 10, and further teaches that the first digital image is stored in an image database included in a client computer coupled to the host computer (column 1, lines 22 through 58, being archived data stored in the permanent storage of a client computer).

Regarding **claim 12**, Barton discloses the method discussed above in claim 11, and further teaches that the pointed to edit list is stored in an edit list database included in the host computer (column 6, line 55 through column 8, line 26).

Regarding **claim 13**, Barton discloses the method discussed above in claim 12, and further teaches that the first digital image is forwarded to the host computer wherein the

Art Unit: 2622

processor processes the first digital image based upon processing instructions included in the pointed to edit list to form the second digital image (column 6, line 1 through column 7, line 53).

Regarding **claim 19**, Barton discloses the method discussed above in claim 1, and further teaches that the first multimedia asset is an audio asset and wherein the second multimedia asset includes the audio asset (column 5, line 64 through column 6, line 31).

8. **Claims 1-9, and 20-35** are rejected under 35 U.S.C. 102(e) as being anticipated by Parulski *et al.* (U.S. Patent Number 6,567,119).

Regarding **claim 1**, Parulski discloses a method of modifying a first multimedia asset (original thumbnail image 98, being an unmodified version of a thumbnail image, column 5, line 63 through column 6, line 32) to form a second multimedia asset (modified thumbnail image 23, column 6, lines 18 through 21, and column 7, lines 18 through 20) comprising applying a multimedia asset processing command (the extension property set 22, see Fig. 5) to the first multimedia asset to form the second multimedia asset (column 5, line 63 through column 6, line 32, and column 7, line 24 through column 8, line 25), and uniquely linking the first multimedia asset to the second multimedia asset to the second multimedia asset using the multimedia asset processing command (see Fig. 5) such that the first multimedia asset (original thumbnail image 98) is derivable solely from the second multimedia asset (column 6, lines 27 through 32, and column 8, lines 11 through 25).

Regarding **claim 2**, Parulski discloses the method discussed above in claim 1, and further teaches that the applying comprises determining if the first multimedia asset is associated with an edit list that includes the multimedia asset processing command (advance edits list 100, see Figs.

Art Unit: 2622

5 and 6), retrieving the edit list (column 5, line 63 through column 6, line 32), processing the first multimedia asset using the multimedia asset processing command included in the edit list (column 5, line 63 through column 6, line 32, and column 8, lines 11 through 25), and outputting the processed first multimedia asset in the form of the second multimedia asset (column 7, lines 6 through 20, and column 8, lines 11 through 25).

Regarding *claim 3*, Parulski discloses the method discussed above in claim 2, and further teaches that the linking comprises associating an edit list pointer (being the metadata) with the second multimedia asset that points back to the edit list (column 6, lines 4 through 32, see Fig. 5).

Regarding *claim 4*, Parulski discloses the method discussed above in claim 2, and further teaches that the linking comprises embedding the edit list in the second multimedia asset (column 5, line 63 through column 6, line 32, see Fig. 5).

Regarding *claim 5*, Parulski discloses the method discussed above in claim 2, and further teaches that when the first multimedia asset does not have an associated edit list, or the associated edit list is empty (column 6, lines 46 through 64, being when the extension persistence value of the extension property set 22 is set as 0x1), then the first multimedia asset is a reference multimedia asset (column 6, lines 46 through 64, whereby when the extension persistence value of the extension property set 22 is set as 0x1, any modification to the core elements would remove the extension file, thereby leaving the standard thumbnail image 23 as a reference asset).

Regarding *claim 6*, Parulski discloses the method discussed above in claim 2, and further teaches that the applying is performed by a processor arranged to perform executable instructions (column 5, lines 28 through 45).



Regarding **claim 7**, Parulski discloses the method discussed above in claim 6, and further teaches that the first multimedia asset and the second multimedia asset is a first digital image and a second digital image, respectively (column 5, lines 11 through 27, and column 5, line 63 through column 6, line 32).

Regarding **claim 8**, Parulski discloses the method discussed above in claim 7, and further teaches that the multimedia processing command provides (extension property set 22) the processor with appropriate digital image processing instructions (column 6, lines 4 through 27).

Regarding **claim 9**, Parulski discloses the method discussed above in claim 8, and further teaches that the processor is included in a host computer (32) coupled to a distributed network of computers (see Fig. 3).

Regarding **claim 20**, Parulski discloses a digital image processing system (see Fig. 3) comprising an input controller (application programs for the interface within computer 32, column 5, lines 16 through 42) arranged to receive an input digital data stream (column 4, lines 29 through 45, and column 5, lines 46 through 67), determine whether or not the input digital data stream includes a first digital image (column 6, line 33 through column 7, line 9), determine whether or not the input digital data stream includes a digital image processing instruction (being an extension property set 22 of a FlashPix file, seen in Fig. 5, column 6, line 33 through column 7, line 9), output a second digital image (image data within the CFA image data field 94, column 5, lines 63 through 67), an image processor (being the application programs for the output interface inherently within computer 32 that is connected to printers 60 or 74, column 5, lines 28 through 45) coupled to the input controller arranged to receive the second digital image (CFA image data 94) when the input data stream includes the digital image processing instruction

Art Unit: 2622

(column 8, lines 8 through 22, whereby the extension property set 22 is part of the FlashPix file, as seen in Fig. 5), and a digital image processing instruction processor (application programs in computer 32, column 5, lines 28 through 45) coupled to the input controller and the image processor arranged to, direct the input controller to output the second digital image (CFA image data 94) to the image processor when it is determined that the input data stream includes the digital image processing instruction (column 6, line 33 through column 7, line 46), and provide the digital image processing instruction (being the extension property set 22) to the image processor (column 6, line 65 through column 7, line 27), wherein the image processor modifies the second digital image (CFA image data 94) based upon the digital image processing instruction to form an output digital data stream (column 6, lines 23 through 27, and column 7, line 6 through column 8, line 22).

Regarding *claim 21*, Parulski discloses the system discussed above in claim 20, and further teaches that when the input digital image stream includes the input digital image and does not include the digital image processing instruction (column 6, lines 46 through 64, being when the extension persistence value of the extension property set 22 is set as 0x1), then the input digital image is a reference digital image (column 6, lines 46 through 64, whereby when the extension persistence value of the extension property set 22 is set as 0x1, any modification to the core elements would remove the extension file, thereby leaving the standard thumbnail image 23 as a reference asset).

Regarding *claim 22*, Parulski discloses the system discussed above in claim 21, and further teaches that the digital image processing instruction is one of a plurality of digital image processing instructions (column 6, lines 4 through 32).

Regarding **claim 23**, Parulski discloses the system discussed above in claim 22, and further teaches that the plurality of digital image processing instructions is included in an edit list (advanced edits list 100, seen in Fig. 5, and column 6, lines 4 through 32).

Regarding **claim 24**, Parulski discloses the system discussed above in claim 23, and further teaches that when the digital image processing instruction is an edit list pointer that points to the edit list (being the metadata, column 6, lines 4 through 32), the image processor directs the input controller to fetch the edit list based upon the edit list pointer (column 6, lines 4 through 32).

Regarding **claim 25**, Parulski discloses the system discussed above in claim 24, and further teaches that the digital image processing instruction is a digital image pointer that points to a location of the first digital image (being the metadata, which lists the CFA pattern and the compression method of the first digital image, column 6, lines 4 through 32), the image processor directs the input controller to fetch the first digital image based upon the pointed to location (being the metadata, which lists the CFA pattern and the compression method of the first digital image, column 6, lines 4 through 32).

Regarding **claim 26**, Parulski discloses the system discussed above in claim 25, and further teaches that the digital image processing system is coupled to a host computer that is linked to a distributed network of computers (see Fig. 3, and column 5, lines 34 through 45).

Regarding **claim 27**, Parulski discloses the system discussed above in claim 26, and further teaches that the distributed network of computers is an HTTP protocol type network of computers (column 5, lines 34 through 45, wherein the internet is an HTTP protocol type network).

Regarding **claim 28**, Parulski discloses the system discussed above in claim 27 (as understood by the examiner), and further teaches that the input digital data stream is generated by a digital appliance coupled to the host computer (see Fig. 3, column 4, lines 29 through 61).

Regarding **claim 29**, Parulski discloses the system discussed above in claim 28, and further teaches that the digital appliance generates the input digital image stream having an embedded digital image and an embedded edit list associated with the digital image (column 4, line 46 through column 5, line 67), wherein the embedded edit list includes digital image processing instructions suitable for modification of the digital image (column 5, line 63 through column 6, line 32, see Fig. 5).

Regarding **claim 30**, Parulski discloses the system discussed above in claim 29, and further teaches that the input controller retrieves the embedded digital image and the associated edit list from the input digital image stream (column 5, line 46 through column 6, line 32), processes the digital image based upon the retrieved digital image processing instructions, identifies and stores the processed image (column 6, lines 23 through 32, column 7, lines 6 through 46, and column 8, lines 11 through 25).

Regarding **claim 31**, Parulski discloses the system discussed above in claim 30, and further teaches that a client computer coupled to the host computer retrieves the identified processed image (remote computer 72, seen in Fig. 3, column 5, lines 38 through 45).

Regarding **claim 32**, Parulski discloses the system discussed above in claim 28, and further teaches that the digital appliance generates the input digital image stream having an embedded digital image and an associated embedded edit list pointer (being embedded metadata, column 4, line 46 through column 5, line 67), wherein the embedded edit list pointer identifies an

Art Unit: 2622

embedded edit list location of the embedded edit list that includes digital image processing instructions suitable for modification of the embedded digital image (column 5, line 63 through column 6, line 32, see Fig. 5).

Regarding **claim 33**, Parulski discloses the system discussed above in claim 32, and further teaches that the input controller retrieves the embedded digital image and the associated edit list based upon the embedded edit list pointer (column 5, line 46 through column 6, line 32), processes the digital image based upon the retrieved digital image processing instructions, identifies, and stores the processed image (column 6, lines 23 through 32, column 7, lines 6 through 46, and column 8, lines 11 through 25).

Regarding **claim 34**, Parulski discloses the system discussed above in claim 33, and further teaches that a client computer (remote computer 72) coupled to the host computer retrieves the identified processed image (column 5, lines 38 through 45, and column 7, lines 6 through 20).

Regarding **claim 35**, Parulski discloses the system discussed above in claim 28, and further teaches that the digital appliance is selected from a group comprising a digital camera (digital camera 30, column 4, lines 29 through 37), a digital camcorder, a digital television, a digital photo scanner, photo-enabled set-top box, a photo enabled game machine, and a photo enabled internet device (column 5, lines 28 through 52).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 14-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (U.S. Patent Number 5,912,972) in view of Parulski *et al.* (U.S. Patent Number 6,567,119).

Regarding **claim 14**, Barton discloses the method discussed above in claim 13, but fails to specifically teach if the host computer further includes a decimator unit to produce a low-resolution thumbnail image of the second digital image. Parulski discloses a method (discussed above in claims 1-9) further teaching that the first digital image is stored in an image database included in a client computer (remote computer 72) coupled to the host computer (see Fig. 3, whereby the thumbnail image data 98 is included in the FlashPix file transmitted over transmission link 70 to the remote computer 72). Further, Parulski teaches that the host computer includes a decimator unit to produce a low-resolution thumbnail image of the second digital image (column 5, lines 46 through column 6, line 32, whereby a decimator would inherently be included so as to produce a thumbnail image). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Parulski in the system of Barton. Barton's system would easily be modified to include Parulski's teachings, as the systems share cumulative features, being additive in nature.

Regarding **claim 15**, Barton and Parulski disclose the method discussed above in claim 14, and Parulski further teaches that the thumbnail image is forwarded to the client computer

(remote computer 72, column 5, lines 38 through 45) and displayed on a display unit coupled thereto (remote output device 74, see Fig. 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the further teachings of Parulski in the system of Barton. Barton's system would easily be modified to include Parulski's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 16*, Barton and Parulski disclose the method discussed above in claim 15, and Parulski further teaches that the second digital image is forwarded to the client computer based upon the thumbnail image (see Fig. 3, whereby the modified thumbnail image data 23 is included in the FlashPix file transmitted over transmission link 70 to the remote computer 72). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the further teachings of Parulski in the system of Barton. Barton's system would easily be modified to include Parulski's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 17*, Barton and Parulski disclose the method discussed above in claim 16, and Barton further teaches that the first digital image and the second digital image are each a first still digital image and a second still digital image, respectively (column 5, line 40 through column 6, line 12).

Regarding *claim 18*, Barton and Parulski disclose the method discussed above in claim 17, and Barton further teaches that the first still digital image is one of a first plurality of digital video images that taken together form a first video and wherein the second still digital is one of a second plurality of digital video images that taken together form a second video (column 1, lines 14 through 42, and column 5, line 64 through column 6, line 12).

***Citation of Pertinent Prior Art***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**Crosby *et al.*** (U.S. Patent Number 6,577,311), being the same inventive entity as the current application, claim a method of generating a digital image at a selected resolution;

**McCarthy *et al.*** (U.S. Patent Number 6,335,983) discloses a system that can reconstruct an extended color gamut digital image from a processed limited color gamut digital image using metadata tags; and

**Daly *et al.*** (U.S. Patent Number 5,859,920) discloses a system that embeds digital information in an image, which can be extracted to recover the original image.



Art Unit: 2622

*Conclusion*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



Joseph R. Pokrzywa  
Examiner  
Art Unit 2622

jrj